

Application No.: 10/664054

Case No.: 58998US002

REMARKS

Claims 1 through 6, 12, and 20 are canceled without prejudice. Claims 7-11 and 13-19 are withdrawn. New claims 21-38 have been added.

New claims 21 through 38 more clearly and distinctly present various aspects of the claimed invention as described in the specification. Applicant notes that claims 35 through 38 are similar to claims withdrawn by the Examiner on the basis of the restriction requirement, and to the extent that the Examiner would apply the same analysis to these claims as to the restriction of previous claims 7 through 11, Applicants respectfully request reconsideration. Claims 35 through 38 properly depend from new claim 21, directly or indirectly, and simply add further steps to the method of claim 21. If claims 35 through 38 are restricted out of the present application, they would have to be added to a future divisional application together with base claim 21, resulting in needlessly complex prosecution of multiple patent applications when instead they may be properly prosecuted as dependent claims in this application. Favorable consideration of new claims 21 through 38 is respectfully requested.

II. Election/Restriction

The Examiner asserted that the application contained claims to two patentably distinct species of the claimed invention: Species A (claims 1 through 6, 12, and 20) and Species B (claims 7 through 11 and 13 through 19). Applicant confirms the election made previously by another of Applicant's representatives to prosecute claims 1 through 6, 12, and 20.

III. Rejection of Claims Under 35 U.S.C. 102

The Examiner rejected claims 1, 3, 5, and 6 under 35 U.S.C. 102(b) as being anticipated by WO 01/45559 A1 (Peterson). In the interests of advancing prosecution on the merits, the rejections applied to claims 1 through 6, 12, and 20 set forth in the Office Action will be addressed below, and to the extent that the same or similar rejections would be advanced against new claims 21 through 38, the analysis below applies as appropriate.

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Peterson, according to the Examiner, teaches the process of claim 1 for laser marking a dental container, including the steps of "providing a container having an exterior surface and an interior chamber, the container formed from a thermoplastic material *and including a laser enhanced outer layer . . .*" Office Action at pages 3-4 (emphasis added). However, claim 1 requires that "the container [is] formed from a laser-enhanced polymer," not that there is just an outer layer of a laser-enhanced polymer. As a result, even if Peterson discloses what the Examiner suggests, it does not disclose the invention of claim 1 because claim 1 requires that the container be formed from a laser-enhanced polymer. Claim 1 is therefore not anticipated under 35 U.S.C. 102(b) by Peterson, and both claim 1 and the claims that depend from it are believed to be in condition for allowance.

#### IV. Rejection of Claims Under 35 U.S.C. 103

The Examiner rejected claims 1 through 6, 12, and 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,100,320 (Martin et al.) in view of U.S. Patent No. 5,977,514 (Feng et al.). The Examiner noted in regard to claims 1 through 4 that Martin et al. "do not teach forming a marking using laser radiation from a Nd:YAG laser, wherein said mark is a letter or a bar code." Although that statement is true, in fact Martin et al. do not teach forming a marking of any kind on the cartridge described in that reference, whether by laser, ink printing, or pencil. The reference is altogether silent on the subject of marking, which makes any combination of that reference with another reference that discloses laser marking suspicious because there is no apparent motivation to combine.

The Examiner then turns to Feng et al. for its disclosure of laser marking of nylon materials. Feng et al., however, do not disclose laser marking of dental packaging materials, or for that matter packaging materials of any type. As a result, the Examiner's suggestion that it would have been obvious to one of ordinary skill in the art to use "the laser marking of Feng et al. ('514) in the process of Martin et al. ('320) for a variety of advantages that laser marking provides" cannot bind the two references together. Martin et al. disclose dental packaging but do not disclose marking of any kind, and Feng et al. disclose marking but do not disclose packaging (much less dental packages) of any kind. Accordingly, there is no suggestion or motivation to

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combine the two references in the manner proposed, and claim 1 is not obvious in view of any combination of the two. The remaining claims that depend from claim 1 are also patentable for at least the same reasons, and reconsideration of the rejection of claims 1 through 6 is respectfully requested.

The Examiner also rejected claims 2 and 4 under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Feng et al. Claims 2 and 4 both depend directly from claim 1, which is believed to be patentable for the reasons presented above. In particular, Peterson does not disclose or suggest that the container is "formed from a laser-enhanced polymer," and thus it cannot anticipate or render obvious claim 1. Accordingly, claims 2 and 4, which include the same requirement, are similarly in condition for allowance, and reconsideration of the rejection of claims 2 and 4 under 35 U.S.C. 103(a) is respectfully requested.

Finally, the Examiner rejected claims 12 and 20 under 35 U.S.C. 103(a) as being unpatentable over Peterson. The Examiner indicated that although Peterson does not specifically teach marking a plurality of containers, "marking a plurality of containers when marking a single container is known," citing In re Harza. Claims 12 and 20 depend directly from claim 1, and thus are patentable for the same reasons presented above that claim 1 is patentable. Furthermore, claim 12 does not claim the sequential exposure of individual containers to laser generated radiation – a sort of repeated, separate application of claim 1 to a series of individual containers. Claim 12 claims the exposure of exterior surfaces of a plurality of containers to laser generated radiation "during a single pass" of that radiation over the containers. This is a type of batch processing that is not disclosed or suggested in the applied prior art, and thus claim 12 also patentable over that art for reasons in addition to those described for claim 1. Reconsideration of the rejection of claims 12 and 20 is therefore respectfully requested.

#### V. Conclusion

Claims 21 through 38, which present various aspects of the present invention, are believed to be in condition for allowance for at least the reasons presented above in support of the patentability of the claims previously pending. If a telephonic interview with Applicants'

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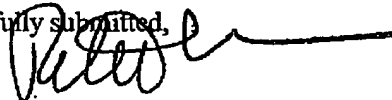
undersigned representative would be useful in resolving any remaining matters related to the application, the Examiner is invited to contact the undersigned, in Brussels, Belgium, at 011-322-722-4541.

June 26, 2006.

Date

Office of Intellectual Property Counsel  
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Respectfully submitted,



By: \_\_\_\_\_

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